

REMARKS

Applicant submits these Remarks in reply to the Office Action mailed February 18, 2010 ("Office Action"). Claims 1-30 are pending in this application, of which claims 1, 11 and 21 are independent.

In the Office Action, the Office took the following actions:

(1) rejected claims 1-30 under 35 U.S.C. § 103 as being unpatentable over "Sharing the Load ("Strozniak")" and "A Personal-Computer Assisted Decision Support System for Private Versus Common Carrier Selection ("Min")," and

(2) withdrew the rejection of claims 1-10 under 35 U.S.C. § 101.

Applicant appreciates the Office's reconsideration of the § 101 rejection and withdrawal thereof. However, Applicant respectfully traverses the § 103 rejection as follows.

I. 35 U.S.C. § 103(a)

Applicant respectfully traverses the Office's rejection of claims 1-30 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims because the combined teachings fail to disclose, teach, or suggest the invention as claimed.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed limitation would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the

public in possession of the claimed invention." M.P.E.P. § 2145(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obvious under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966) The factual inquiries [include determining the scope and content of the prior art and] [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A. The cited references do not teach "analyzing past load history based on dedicated and common carrier rates"

The cited references, either alone or in combination, do not teach or suggest "analyzing past load history based on dedicated and common carrier rates" as recited in Applicant's independent claims 1, 11, and 21. In rejecting independent claims 1, 11, and 21, the Office correctly asserts that "Strozniak fails to explicitly teach analyzing *past* load history based on dedicated and common carrier rates." Office Action at 3; *see id.* at 8. Instead, the Office relies on *Min* for teaching "analyzation of historic data associated with load transport as a way to chose between common and private carriers" and "the use of historic data to perform the carrier selection (page 234, methods such

as exponential smoothing are used to evaluate data." *Id.* Applicant respectfully disagrees with this reading of *Min*.

Fundamentally, Applicant respectfully submits that the Office has failed to even argue that the combination of *Strozniak* and *Min* teach "analyzing past load history based on dedicated and common carrier rates" as required by the claims. Instead, the Office merely states that "Min teaches analyzation of historic data associated with load transport as a way to chose between common and private carriers." Office Action at 3. However, the Office failed to explain how the phrases "historic data associated with load transport" and "past load history" are equivalent. For instance, the Office points page Table 1 of *Min* as teaching "historic data associated with load transport," but that table only lists the "standardize[d] cost structures and break down cost elements" *Min* at 231. These elements include such factors as rates per mile, rates per pound, depreciation, capital costs, and various other fees, but does not include an analysis of "past load history." See *id.* By only considering specific costs associated with load transport, the Office has effectively failed to consider all limitations of the claims. See M.P.E.P. § 2143.03 ("All words in a claim must be considered in judging the patentability of a claim against the prior art.")

Aside from the adequacy of the Office's argument, the combination of *Strozniak* and *Min* does not teach "analyzing past load history." *Min* discloses an "assisted decision support system (DSS) which aims at aiding logistics managers in selecting the most appropriate transportation choice between private and common carriers." *Min* at 229. *Min* teaches "evaluat[ing] the tradeoffs between private and common carriage by taking into account" various factors such as fleet cost, service quality, loss and damage

liability, driver availability, and company image and goodwill. *Id.* at 231-33. All of these considerations are related to the future and upcoming costs associated with the different carrier alternatives and none relate to “past load history.”

More importantly, the disclosure of *Min* relied upon by the Office actually teaches away from “analyzing past load history.” “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.02(vi) 8th Ed., Rev. 6 (Sept. 2007) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). “A reference may be said to teach away . . . if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *Tec Air Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999).

The Office alleges that *Min*’s reference to exponential smoothing to evaluate data shows the “use of historic data to perform the carrier selection.” Office Action at 3. However, a closer look reveals that *Min* does not use such methods to “analyz[e] past load history based on dedicated and common carrier rates.” Indeed, *Min* explains that:

The forecasting techniques aim to estimate the outbound shipment size and schedule according to real-time changes in customers’ demand and delivery requirements . . . In particular, the JIT delivery system that Master Lock uses requires flexibility in shipping schedules and thus causes some variations in delivery arrangements. To reduce such variations and the subsequent delivery uncertainty, it is practical to *estimate daily customer demand and delivery requirements using some short-term forecasting techniques such as exponential smoothing.*

Min at 234 (emphasis added). In other words, *Min* contemplates forecasting future customer demands and requirements to decide between private and common carriers rather than “analyzing past load history based on dedicated and common carrier rates.” By looking toward the future, *Min* expressly teaches away from the claimed invention and, consequently, the Office has not clearly articulated a reason why the claimed invention would have been obvious.

B. One Of Ordinary Skill In The Art Would Not Modify *Strozniak* As Suggested

The Office Action asserts that it would have been obvious to “include in the system of *Strozniak* the ability to analyze past load history based on dedicated and common carrier rates as taught by *Min* since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately.” Office Action at 3. Applicant respectfully disagrees. Combining the system of *Strozniak* with the analysis of common carrier rates in *Min* would render *Strozniak* unsatisfactory for its intended purpose.

It is well settled that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, if the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. § 2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Here, and as discussed in Applicant’s Response to Office Action filed June 30, 2009, *Strozniak* teaches a system of “reducing costs by sharing truck capacity and

warehouse operations, and consolidating small shipments from several companies onto one truck." *Strozniak* p. 2, ¶ 1. Thus, the essence of this approach is that shipping efficiencies can be improved by combining shipments from at least two companies onto one truck. Necessarily, common carrier rates are not considered as they would only benefit one company, and cut against the level of "collaboration" contemplated by *Strozniak*. In other words, the addition of common carriers to the *Strozniak* analysis would necessarily undermine the stated goal of collaboration between companies. If the companies described in *Strozniak* began using common carriers, the system would break down as there would be fewer partners with whom companies could collaborate and share shipping costs. Indeed *Strozniak* lists the lack of vendors and the participants reluctance to share information as the primary drawbacks of collaborative logistics. *Strozniak* p. 3, ¶¶ 1-3. The introduction of common carrier options would only exacerbate these problems. By focusing on how to improve the efficiencies of multiple companies, *Strozniak* must avoid solutions which would benefit a single company to the possible detriment of another.

The Office's proposed modification of *Strozniak* to include the analysis of common carrier rates, as described in *Min*, would render *Strozniak* unsatisfactory for its intended purpose, which is to "reduc[e] costs by sharing truck capacity and warehouse operations, and consolidating small shipments from several companies onto one truck." *Strozniak* p. 2, ¶ 1. Accordingly, because the introduction of common carriers would result in fewer pairings and less collaboration, Applicant submits that the Office has failed to articulate a reason to combine *Strozniak* and *Min*.

C. No *Prima Facie* Case Of Obviousness

For at least the above reasons, the Office Action fails to clearly articulate a reason why *Strozniak*, either alone, or in combination with *Min*, would have rendered the claimed invention obvious to one of ordinary skill in the art. Consequently, a *prima facie* case of obviousness has not been established.

Because no *prima facie* case exists, Applicant respectfully requests that the Office withdraw the rejection of independent claims 1, 11, and 21. Because dependent claims 2-10, 11-20, and 22-30 necessarily contain recitations of one of the independent claims, Applicant also requests withdrawal of the rejection of the dependent claims for the same reasons, and allow pending claims 1-30.

II. Conclusion

The preceding remarks are based solely on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

In view of the foregoing remarks, Applicant submits that this claimed invention is not rendered obvious in view of the prior art reference cited against this application. Applicant therefore requests the entry of this reply, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

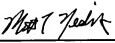
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: April 2, 2010

By: _____


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